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PCT LEGAL ADMINISTRATION

In re Application of :
WALDMANN et al :
Application No: 09/129,758 : DECISION ON PAPERS
PCT No.: PCT/FR98/00270 :
Int. Filing Date: 11 Feb 1998 : UNDER 37 CFR 1.42
Priority Date: 11 Feb 1997 :
Attorney's Docket No.: 328255US0PCT :
For: MAMMAL NEURONAL ACI SENSING :
CATIONIC CHANNEL, CLOSING AND :
APPLICATIONS THEREON :

This decision is in response to the submission filed 15 September 2010, which is being treated as a renewed request for status under 37 CFR 1.42.

BACKGROUND

In a decision mailed 15 July 2010, applicants' petition to revive the present application under 37 CFR 1.137(b) was granted and the request for status under 37 CFR 1.42 was dismissed. The decision set a two-month time period to furnish an oath or declaration in compliance with 37 CFR 1.497. The decision noted that declarations filed 07 July 2010 failed to comply with 37 CFR 1.497 because they failed to identify the mailing address and citizenship of the legal representatives and the citizenship of the deceased inventor, and did not include complete copies of the executed declarations.

On 15 September 2010, applicants filed declarations considered herein.

DISCUSSION

Foreign language declarations

37 CFR 1.69(b), provides:

(b) Unless the text of any oath or declaration in a language other than English is in a form provided by the Patent and Trademark Office or in accordance with PCT Rule 4.17(iv), it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under § 1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation

In the present case, the declarations are in a language other than English and are not in a form provided by the Office. Accordingly, the declarations cannot be accepted absent a statement that the English translation is accurate.

Status under 37 CFR 1.42

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. See 37 CFR 1.42. Such oath or declaration must satisfy the requirements of 37 CFR 1.497(b)(2), which provides:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

In response to the decision mailed 15 July 2010, applicants appear to have amended the previously executed declarations filed 07 July 2010 to include the “mailing address” of the legal representatives, and an indication that the legal representatives and deceased inventor are “French”. It is improper to amend a previously executed declaration. See MPEP §605.04(a), which states, in pertinent part:

In summary, it is emphasized that the application filed must be the application executed by the applicant and it is improper for anyone, including counsel, to alter, rewrite, or partly fill in any part of the application, including the oath or declaration, after execution of the oath or declaration by the applicant. This provision should particularly be brought to the attention of foreign applicants by their United States counsel since the United States law and practice in this area may differ from that in other countries.

Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration.

See also MPEP §602.01:

*The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. ****

It is also not clear that the indication “French” refers to citizenship, as opposed to another indication, e.g., residency. Identification of citizenship is a statutory requirement. See 35 U.S.C. 115. Further, it is noted that while three “legal representatives” have executed the declaration, only one initialed the citizenship of the deceased inventor. If the basis for the legal

representatives executing the declaration on behalf of the deceased inventor is that they are the sole heirs, and an executor or administrator has not been appointed, then all heirs must attest to the citizenship.

CONCLUSION

For reasons above, the request for status under 37 CFR 1.42 is **DISMISSED**, without prejudice.

Applicants have **ONE (1) MONTH** from the mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497(a)-(b) overcoming the above-noted defects. Failure to timely file the proper reply will result in **ABANDONMENT** of the application. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Boris Milef/

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